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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,724	07/06/2006	Bjorn de Bonnenfant	5092-053368	2035

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EXAMINER

OBAYANJU, OMONIYI

ART UNIT	PAPER NUMBER
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2617

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/555,724	Applicant(s) BONNENFANT, BJORN DE	
	Examiner OMONIYI A. OBAYANJU	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22,23,32-37 and 40-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22,23,32-37 and 40-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/10/2007, 02/26/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 22-41 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **42 and 46** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification did not mention an internet home page in the disclosure. Page 8, lines 15-16, stated that "The position indication is forwarded preferably as a link to a home page". The phrase "home page" is a very broad and it does not the same or necessarily implies an "Internet Home page".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by

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the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 22, 37, 42, 44, 46, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamauchi (US Publication No. 20030115095).

As to claims 22 and 37, Yamauchi teaches a method for providing a system that is operated by a first party (fig. 1, #3) with position information from a mobile unit (pg. 3, pp 0062) provided with a unique identity (pg. 1, pp0018, lines 8-9) and belonging to a second party (fig. 1, #4), the first party providing a service that is dependent of the position of the mobile unit (pg. 3, pp 0062), the second party activating the use of the service (pg. 3, pp 0055, lines 10-15), the method comprising the steps of: sending a signal from the mobile unit via a cellular communication network (pg. 2, pp0047 and 0049), when the second party activates the use of the service, to a toll number associated with a certain charge (pg. 3, pp 0067), the signal comprising information regarding the identity of the mobile unit and position indication provided by the cellular communication network depending on which cell the mobile unit is present in, each cell within the cellular communication network (pg. 3, pp 0062) defining a geographic area (gate1 – gate 2); and debiting said charge from an account connected to the mobile unit and said second party (pg. 6, pp 0103); forwarding (transmitting) information regarding identity of the mobile unit (user information) and position indication (pg. 1, pp0013, and pp0021, lines 5-10) to a receiver when the second party activates (invoke turnpike use) the use of the service; and locating (distinguished from a plurality of portable terminal)

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the mobile unit as a response to the received information by the receiver (pg. 1, pp0013).

As to **claims 42 and 46**, Yamauchi teaches wherein the step of locating comprises presenting the information from the unit on an Internet home page (computer communication over the internet) (pg. 2, pp0049, lines 7-12, and pp0148).

As to **claims 44, and 48**, Yamauchi teaches wherein the method further comprises the step of selecting an owner of the toll number (invoking turnpike service use input operation) (pg. 4, pp0084) to be the same (correct) party as the receiver (base station) (pg. 4, pp0084, and pp0089, lines 1-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-35, 38, 41, and 49-50, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi (US Publication No. 20030115095) in view of Ikeda (US Publication No. 20020067291).

As to **claims 33 and 41**, Yamauchi teaches the limitations of claims 22 and 37 as discussed above. However Yamauchi fails to teach a tracking service and the mobile unit automatic updates the present position of the mobile unit. Ikeda teaches tracking of

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truck and freight location (pg. 3, pp0053, lines 1-8) and automatic and manually activation of terminal (pg. 2, pp0034, lines 1-7). Thus, it would have been obvious to one of ordinary skill in the art at time invention was made to combine the teachings of Yamauchi with the teachings of Ikeda to achieve a constant communication link for transmitting signals information and location information in a communication network.

As to claims 34, and 49, Yamauchi teaches wherein the mobile unit is activated at regular intervals (pg. 2, pp0050).

As to claims 35 and 50, Yamauchi teaches wherein the service for the mobile unit may be initiated by sending a message to the unit (pg. 2, pp0049, lines 4-10).

Claims 36 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi (US Publication No. 20030115095) in view of Ikeda (US Publication No. 20020067291) further in view of Irvin (US Patent No. 6556819).

As to claims 36 and 51, Yamauchi and Ikeda teach the limitations of claims 33 and 41 as discussed above. However, they failed to teach at least an external sensor which activates alarm. Irvin teaches a mobile telephone with motion detector that alarms upon change in location (col. 1, lines 20-22). Thus, it would have been obvious to one of ordinary skill in the art at time invention was made to combine the teachings of Yamauchi and Ikeda with the teachings of Irvin to achieve a wireless device that is capable of efficiently detecting a change or movement of the device in a communication network.

Claims 23 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi (US Publication No. 20030115095) in view of Eizenhofer (US Patent No. 5933114).

As to **claims 23 and 45**, Yamauchi teaches the limitations of claims 22 and 37 as discussed above. Yamauchi further teaches wherein the signal that is sent from the mobile unit is sent in the form of a SMS (pg. 2, pp0049, lines 7-10). However, Yamauchi fails to teach the GSM communication network.

But, Eizenhofer teaches the communication network is a GSM network (fig. 1, #1). Thus, it would have been obvious to one of ordinary skill in the art at time invention was made to combine the teachings of Yamauchi with the network teachings of Eizenhofer to achieve a common communication system for implementing the same services provider for easy transition.

Claims 32, 40, 43, 47, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi (US Publication No. 20030115095) in view of Mandel (US Publication No. 20040095248).

As to **claim 32**, Yamauchi teaches the limitations of claim 22 as discussed above. Yamauchi further teaches wherein the service that is provided is a personal

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alarm service (pg. 2, pp0050, lines 1-4). However, Yamauchi fails to teach wherein the service is activated by pushing an alarm button.

But, Mandel teaches wherein the service is activated by pushing an alarm button (pg.1, pp0010, lines 1-4). Thus, it would have been obvious to one of ordinary skill in the art at time invention was made to combine the teachings of Yamauchi and Mandel to achieve a wireless device that is capable of efficiently and accurately detecting a change or movement or condition of the device in a communication network.

As to **claim 40**, Yamauchi teaches the limitations of claim 37 as discussed above. Yamauchi further teaches wherein the service that is provided is a personal alarm service (pg. 2, pp0050, lines 1-4). However, Yamauchi fails to teach the mobile unit includes an alarm button that upon being pushed activates the service.

But, Mandel teaches the mobile unit includes an alarm button that upon being pushed activates the service (pg.1, pp0010, lines 1-4). Thus, it would have been obvious to one of ordinary skill in the art at time invention was made to combine the teachings of Yamauchi with the teachings of Mandel to achieve a wireless device that is capable of efficiently detecting a change or movement of the device in a communication network.

As to **claims 43 and 47**, Yamauchi teaches the limitations of claims 22 and 37 as discussed above. Yamauchi further teaches wherein the service that is provided is a personal alarm service (pg. 2, pp0050, lines 1-4). However, Yamauchi fails to teach wherein the service is activated by not pushing the alarm button (sensor automatically triggered) at predetermined intervals (pg.1, pp0010, lines1-4, and pg. 2, pp0040). Thus,

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it would have been obvious to one of ordinary skill in the art at time invention was made to combine the teachings of Yamauchi and Mandel to achieve a wireless device that is capable of efficiently, accurately, and automatically detecting a change or movement or location of the device in a communication network.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMONIYI A. OBAYANJU whose telephone

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number is (571)270-5885. The examiner can normally be reached on Mon - Fri,
7:30 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Vincent P. Harper can be reached on 571-272-7605. The
fax phone number for the organization where this application or proceeding is
assigned is 571-273-8300.

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/O. A. O./
Examiner, Art Unit 2617

/VINCENT P. HARPER/
Supervisory Patent
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